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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------------|------------------------|
| 10/755,447 | 01/13/2004 | Shuya Shinohara | TAN-331 | 1085 |
| 35777 7590 01/12/2007 SHERMAN & ASSOCIATES 415 NORTH ALFRED STREET ALEXANDRIA, VA 22314 | | | EXAMINER SELLERS, ROBERT E | |
| | | | ART UNIT 1712 | PAPER NUMBER |
| | | | MAIL DATE 01/12/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/755,447

Applicant(s)

SHINOHARA ET AL.

Examiner

Robert Sellers

Art Unit

1712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION: See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 2, 5 and 8.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Robert Sellers
Primary Examiner
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1. The amendment after Final rejection filed December 15, 2006 has been denied entry. The change of the molecular weight from 1000 to 10,000 on page 5, the second full paragraph, line 7 of the specification is not supported by page 6, line 9 of Japanese priority application no. 2001-194802 until a certified English translation is submitted. The Japanese document filed January 13, 2004 cannot be verified as the Japanese priority application since there is no cover sheet identifying the application number and filing date.
2. New claim 11 has been submitted without the cancellation of another claim. Claims 3, 4, 6, 7, 9 and 10 have been previously cancelled.
3. The language of new claim 11 suffers from the confusing depiction of general formula (1) before its description as a reactant after the reacting step with epichlorohydrin.
4. Hartmann et al. Patent No. 4,153,621 discloses the preparation of a diglycidyl ether of 3,3',5,5'-tetraalkyl-4,4'-dihydroxybiphenyl (cols. 3-4, first diglycidyl ether structure) by the reaction of a dihydric phenol with epichlorohydrin (col. 2, lines 59-60) conforming to the product-by-process terminology of claim 1 as amended on August 8, 2006. Kawano et al. Patent No. 7,063,914 sets forth 3,3',5,5'-tetramethylbisphenol F diglycidyl ether (col. 2, lines 24-35) obtained by the reaction of 3,3',5,5'-tetramethylbisphenol F with epichlorohydrin. Newly amended claim 1 and the arguments pertaining to the new language of reacting liquid epoxy resin and an aromatic compound of general formula (1) raises a new issue requiring further consideration.

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5. New claim 11 denotes a process of preparing the epoxy resin of general formula (2) by the reaction of an aromatic compound of general formula (1) and epihalohydrin which was originally defined in claim 1 of the amendment filed August 8, 2006. Claim 11 has the further limitations of a weight average molecular weight of at least 10,000 (whose support is questionable in the absence of a certified English translation of the Japanese priority application) and an epoxy equivalent of 2,100 g/eq or greater (the exact epoxy equivalent of 2,100 g/eq is described on page 6, line 2 of the specification). New claim 11 introduces new issues regarding the previously unconsidered molecular weight and epoxy equivalent ranges. Furthermore, there is no substantiation on page 5, the second full paragraph that the basis for the molecular weight is "weight average."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
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Art Unit 1712